

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Tadashi KURIYAMA et al.

Group Art Unit: 1772

Application No.: 09/555,578

Examiner: B. Egan

Filed: July 26, 2000

Docket No.: 106336

For: TACK LABELS AND PLASTIC CONTAINER WITH SUCH TACK LABELS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the March 1, 2004 Office Action and the June 28, 2004 personal interview, the period for reply extended by the attached one-month Petition for Extension of Time to July 1, 2004, reconsideration of the above-identified application is respectfully requested.

Claims 1, 2, 6-8 and 12 are pending.

Applicants appreciate the courtesies extended by Examiner Egan to Applicants' representative during the June 28, 2004 personal interview. The points discussed are incorporated into the Remarks below and constitute Applicants' record of the interview.

Claims 1, 2, 6-8 and 12 were rejected under 35 U.S.C. §103(a) over GB 2,259,291 (GB'291) in view of Romagnoli, U. S. Patent No. 4,060,168 and Volkman, U. S. Patent No. 5,238,720 and claims 1, 2, 6 and 8 were rejected under 35 U.S.C. §103(a) over Dudzik et al. (Dudzik), U. S. Patent No. 4,444,839 in view of Romagnoli and Volkman. The rejections are respectfully traversed.

As admitted on pages 3 and 6 of the Office Action, neither GB'291 nor Dudzik disclose or suggest a non-adhesive masking layer as recited in Applicants' claims 1 and 8. Applicants assert that the combination of Romagnoli and Volkman also fails to disclose or suggest Applicants' non-adhesive masking layer.

As argued in the December 29, 2003 filed Request for Reconsideration, Applicants clarified their non-adhesive masking layer that is formed in a central part of the adhesive layer so that the adhesive layer has a ring-shaped adhesive area and formed at only a part of an edge of the adhesive area as recited in claim 1 and as similarly recited in claim 8. Applicants argued that Romagnoli fails to disclose the non-adhesive masking layer formed at only a part of an edge of the adhesive area as recited in claims 1 and 8 because Romagnoli discloses a projection section 32 that extends beyond the edge of the label 16 and is thus not formed at only a part of an edge of the adhesive layer.

However, as asserted on pages 3 and 6 of the Office Action, the Examiner states that the use of "may include" in col. 3, line 26 of Romagnoli is inclusive of embodiments that do and do not comprise a projection section 36. As such, the Examiner concludes by stating that Romagnoli teaches a masking layer formed at only a part of an edge of the adhesive area. The Examiner then refers to Volkman to support his position. Applicants respectfully disagree with this position.

Applicants first note that Romagnoli only discloses two embodiments. The embodiment of Figs. 1-6 and the alternative embodiment of col. 3, lines 20-38 and Fig. 7. In describing the alternative embodiment, Romagnoli only provides one set of alternatives that may be included. Romagnoli fails to provide any teaching, disclosure or suggestion as to any other alternative embodiments that may be used. In other words, the use of "may include" in Romagnoli fails to provide any teaching, disclosure or suggestion that the projecting tab 34 can be formed at only a part of an edge of the adhesive area.

Applicants next note that neither Romagnoli nor Volkman disclose a non-adhesive masking layer that is both (1) formed in a central part of the adhesive layer so that the adhesive layer has a ring-shaped adhesive area and (2) formed at only a part of an edge of the adhesive area. As argued above, Romagnoli fails to disclose feature (2). Volkman fails to disclose feature (1). In particular, Volkman only discloses a selected area 17a of the top layer 17, forming a part of the margin of the top layer 17, that is not adhered to the base sheet 18 (Fig. 1 and col. 4, lines 58-63). Volkman fails to teach, disclose or suggest also forming a non-adhesive masking layer in a central part of the adhesive layer so that the adhesive layer has a ring-shaped adhesive area.

Applicant also asserts that the combination of GB'291 or Dudzik with Romagnoli and Volkman fails to render obvious the subject matter of claims 1 and 8. In rejecting claims under 35 U.S.C. 103, a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention must be provided. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

To establish prima facie obviousness of a claimed invention, all the claim features must be suggested or taught by the prior art. It is also impermissible for an Examiner to engage in hindsight reconstruction of the claimed invention using Applicant's structure as a template and selecting elements from references to fill the page.

As admitted, GB'291 and Dudzik are completely silent with respect to the use of a non-adhesive masking layer. As such, there is admittedly no teaching, suggestion or implication in GB'291 or Dudzik to use a non-adhesive masking layer. As argued, Romagnoli and Volkman fail to individually disclose all of Applicants' non-adhesive masking layer. Although the easy removal of a label is desired, Applicants' specific structure is neither

taught nor suggested. As such, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the modification. Romagnoli and Volkman fail to provide such a suggestion.

Accordingly, Applicants assert that none of the applied references disclose or suggest all of the features recited in Applicants' claims 1 and 8 as well as the additional features recited in the dependent claims. It is respectfully requested that the rejection be withdrawn.


Claims 7 and 12 were rejected under 35 U.S.C. §103(a) over Dudzik in view of Romagnoli and Volkman and further in view of Freedman et al. (Freedman), U.S. Patent No. 6,165,576. The rejection is respectfully traversed.

Freedman fails to overcome deficiencies of the other applied references in disclosing or suggesting the non-adhesive masking layer as recited in Applicants' claims 1 and 8. In addition, claims 7 and 12 recite additional features of the invention and are also believed to be allowable at least for the reasons discussed above with respect to claims 1 and 8 and for the additional features recited therein. It is respectfully requested that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 6-8 and 12 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: June 29, 2004

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